ESTTA Tracking number:

ESTTA376317

Filing date:

11/02/2010

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| Proceeding                | 91183753   |
|---------------------------|--|
| Party                     | Defendant<br>Yassinn Patrice Diallo  |
| Correspondence<br>Address | YASSINN PATRICE DIALLO 2 SQUARE TRIBORD COURCOURONNES, 91080 FRANCE yassinn.diallo@laposte.net |
| Submission                | Reply in Support of Motion   |
| Filer's Name              | Yassinn Patrice Diallo   |
| Filer's e-mail            | yassinn.diallo@laposte.net   |
| Signature                 | /yassinn patrice diallo/   |
| Date                      | 11/02/2010   |
| Attachments               | Defendant's Reply in support of motion.pdf ( 26 pages )(9159254 bytes )                        |

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| HEAVEN HILL DISTILLERIES, INC | ) |                        |
|-------------------------------|---|------------------------|
|                               | ) |                        |
| Opposer,                      | ) |                        |
|                               | ) | Opposition No.91183753 |
| V.                            | ) |                        |
|                               | ) | Serial No. 77/266,196  |
|                               | ) | Mark HYPNOTIZER        |
|                               | ) |                        |
| DIALLO YASSINN PATRICE,       | ) | Intl Class: 033        |
|                               | ) |                        |
| Respondent.                   |   |                        |

### **DEFENDANT'S REPLY IN SUPPORT OF MOTION**

Defendant's Yassinn Patrice DIALLO, respectfully requests to the Trade Mark Trial and Appeal Board to reject the plaintiff's response to defendant's Motion to strike plaintiff's reply brief and the observations, arguments and elements sent by the Opposer as they have no ground.

Defendant's, DIALLO YASSINN PATRICE a citizen of France, resident in 2 Square Tribord, 91080 Courcouronnes, France, denies that if his application serial N° 77266196 for the mark HYPNOTIZER is allowed to issue as a registration, it will harm the Opposer HEAVEN HILL Distilleries inc, a Kentucky corporation with its principal place of business at 1064 Loretto Road, Bardstown, Kentucky, U.S.A 40004.

Above all, it is necessary to re-specify the rules of the US and Trade Mark Law U. S. PATENT & TRADEMARK OFFICE June 24, 2010 § 2.127 Motions, regarding the motions.

### § 2.127 Motions.

(a) Every motion must be submitted in written form and must meet the requirements prescribed in § 2.126. It shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. Except as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. The date of service of our motion to strike plaintiff's reply brief was the 1<sup>st</sup> October 2010 and the opponent's brief in response to our motion date of service was the 21st October 2010 more than fifteen days allowed by the rules, so their response to our motion must be rejected according to the the US and Trade Mark Law U. S. PATENT & TRADEMARK OFFICE June 24, 2010 § 2.127 Motions.

Moreover our motion was not an attempt to submit a reply brief, indeed Heaven Hill has stated that Diallo's submission violates the rules set forth in 37 C.F.R § 11.18(b) and then the Board should terminate this proceeding in Heaven Hill's favor pursuant to 37 C.F.R 11.18). That is why we had shown in providing the evidence why the Board should not strike Diallo's Brief.

Heaven Hill knowing that the brief was true with regard to these statements, Mr DIALLO Yassinn Patrice has requested in turn the Board to notice that the false statements of Heaven Hill violate the rule set forth in 37 C.F.R § 11.18 (b), therefore the Board should strike Heaven Hill Briefs in its entirety and terminate this proceeding in favor of Mr DIALLO Yassinn Patrice pursuant to 37 C.F.R § 11.18 (c).

It is therefore understood clearly that the motion to strike the Opposer's reply brief was not an attempt made by applicant to file a reply brief but to dismantle supporting evidences that Heaven Hill and his counsel Mr Matthew A Williams carried serious charges to create the impression that DIALLO Yassinn Patrice wanted to induce the Board into error by false evidence and false statements. Thus the jurisprudence Levi Strauss & Co. v. R. Josephs Sportswear Inc.., 28 USPQ2d 1464, 1465 n.3 (TTAB 1993) is not admissible. Moreover Heaven Hill had previously falsely claimed to have waited 3 weeks to receive our letter from France which is impossible, because the delivery time is 6 days exhibit (A).

1. <u>Heaven Hill misrepresentations regarding Diallo's right to use the HYPNOTIZER mark</u> in connection with beverage alcohols products.

Heaven Hill continues to misrepresent the status of Diallo's rights for the HYPNOTIZER MARK in France and the UK. Mr Diallo has the right to use HYPNOTIZER mark in connection with alcohol in France, but in our present case we are before the US TTAB and US Federal trademark Laws.

In France the registration certificate includes beverages in connection with alcohols. The terms beverages that he has chosen and which is registered in his certificate of registration has a general impact and covers alcoholic beverages and others despite their belonging to different administrative classes (32, 33).

Indeed in France instead of the United States, although the different products and services have been "sorted" by class, this administrative classification has no legal value. Thus the Opposer is struggling to understand the peculiarities of French laws on the subject. Thus what account it is the term which appears on the certificate of registration, which for lack of containing the term not alcoholic drinks in a literal way, allows to market alcoholic beverages. Contrary to the assertion of the Opposer, the term non-alcoholic drinks "aperitifs are alcohol

free" is one of the terms mentioned in the certificate in class 32, but there are also among else "« syrups and the other preparations to make beverages, vitamins beverages, energy drinks » " Furthermore the Court of Appeal has no jurisdiction in France to order the registration of a trademark dispute nor to declare void the mark claimed by the Opposer, the Court of Appeal can only reject an appeal or annul a decision referred to him without being able to substitute his own decision. In fact, only the statements made in the final registration certificate are authentic.

Diallo's registration for HYPNOTIZER in connection with some alcoholics Beverages is therefore completely and absolutely true and was not made intentionally and knowingly made to advance the Board his position.

In the UK as well as for the case in the USA for these two trade marks for HYPNOTIZER N° 77266196 and 79019547, the application for each mark was made at different times and therefore they were treated as different cases. In the UK as well as in the USA the two marks have been deposited at different times M 873089 and 2462677; moreover M873089 mark comprises in addition the term "beer" in class 32, which was not the case of the mark 2462677. The decision was made for the mark 2462677 not M 873089.

As the United States, the UK depends on the Madrid Protocol so there is the safeguard clause, which applies. In the United Kingdom the case number 873089 remains pending (exhibit B). The decision of March 30th, 2010 does not relate to the same case (exhibit C) case 2462677. Mr DIALLO YASSINN PATRICE statements and representations in his brief are completely and absolutely true and are not intentionally and knowingly made to the Board to advance his position.

### 2. The testimony of Heaven Hill Witnesses and exhibits introduced are not admissible.

37 C.F.R 2.123 (c) Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

For these reasons we request the TTAB to reject the testimony and the evidences and arguments provided during the testimony of Drew Wesley, Justin Ames and the direct examination made by Matthew Williams, as they are the public relation, employees and legal counsel of the Opposer Heaven Hill Distilleries. Moreover Yassinn Patrice DIALLO does not have evidence to invent, besides he is not right to question people who work and are paid by the Opposer (c) Disqualification for Interest.

#### 3. Registration of Diallo's HYPNOTIZER Mark will not cause confusion.

Diallo Yassinn Patrice seeks registration for HYPNOTIZER mark, which is completely different in terms of products, mark, packaging, size, price (exhibit D).

Hypnotizer mark is not made for flavored sparkling water as the opponent lawyer try to affirm. The opposite party can clearly see that in October 2005 a registration certificate was delivered by French NIPO for HYPNOTIZER with a specific design (exhibit E). Opposed to what the Opposer lawyer intends to demonstrate, HYPNOTIZER application is for specifics beverages including rum, as mentioned on the certificate design (exhibit F).

It is clear evidence that we claim a special style, with a special bottle, and with colors and specific design, completely different from the opponent design (exhibit G). It is clear evidence that we apply for a specific mark and a specific design completely different to the opposed mark and design, and not only a mark as a word. As opposed to what the opposing party

affirms, Respondent Diallo Yassinn Patrice does not want to register the HYPNOTIZER mark for liqueur (exhibit H), and as it is indicated on his Application form.

The registration for HYPNOTIZER is filed for specifics products such as: Alcoholic beverages produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholics malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard Cider, Natural Sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, Wines.

Applicant denies the allegation of the Opposer concerning the fact that the Applicant Diallo Yassinn Patrice wants to register the HYPNOTIZER mark in connection with liqueur because it is absolutely false. For these reasons Diallo Yassinn Patrice application to register his HYPNOTIZER mark will not cause confusion, mistake, deception, or affiliation with HEAVEN HILL'S HPNOTIQ mark for liqueur.

HPNOTIQ is used for a specific product the liqueur (exhibit I), HYPNOTIZER is used for different products, there's no likelihood of confusion and moreover of dilution between the two Trade Marks. Diallo Yassinn Patrice's application should be registered pursuant to 15 U.S.C §§ 1052, 1063.

Moreover Heaven Hill also claims the name HPNOTIZER supposedly since May 2005 while their lawyer in France knew the registered trademark of Mr Patrice Diallo Yassinn since February 2005 (exhibit J). In May 2005, the lawyer of HEAVEN HILL in France contacted the Applicant requesting that the Applicant abandon his trade mark HYPNOTIZER (exhibit K). The Opposer incorrectly states that he won the case in France against the registration of HYPNOTIZER for alcoholic beverages. This is not accurate as Applicant owns the trade

mark HYPNOTIZER in France. As you may see (exhibit L), the Opposer requested Applicant

not to market his products where HPNOTIQ is present. This request is illegal and has no

ground.

The Opposer claims having a decision preventing Mr. Diallo from using HYPNOTIZER trade

mark for alcoholic beverages in France and United Kingdom. The case in the United

Kingdom is not yet closed as Applicant Diallo Yassinn Patrice has filed for alcoholic

beverages and this is pending decision (exhibit M). Hence the Opposer's statement is not

accurate.

**CONCLUSION** 

Diallo's motion to strike plaintiff's reply brief was made in accordance with rules established

by the Board and is perfectly legal. Moreover the Board should strike Heaven Hill's response

to motion because it was made more than fifteen days allowed by the rules and Trade

Mark Law US PATENT & TRADEMARK OFFICE June 24, 2010 § 2127 motions, and

because the assertions in the brief of the Opposer are false.

For these reasons Diallo's application for the mark HYPNOTIZER should be registered

pursuant to 15 U.S.C § 1052(d) and HEAVEN HILL opposition denied.

Respectfully submitted

**DIALLO YASSINN PATRICE** 

7

### **PROOF OF SERVICE**

I hereby certify that a true and correct copy of Defendant's reply in support of motion was served on the following attorney for Opposer by deposit in the French Mail, in Paris France, in a sealed envelope, with first class postage fully prepaid this 1<sup>st</sup> November 2010.

Matthew A. Williams

Wyatt Tarrant & Combs, LLP

500 West Jefferson Street, Suite 2800

Louisville, KY 40202

**UNITED STATES** 

502-562-7378 Telephone

Dated: November 1st, 2010

DIALLO YASSINN PATRICE

### EXHIBIT A

| FICHE DE DÉPÔT D'UN REC  | OMMANDÉ INTERNATIONAL E   |
|--|---|
| Cadres réservés à La Poste   | Destinataire :  |
| CRBT PARIS RIVE Granche  Date de dépôt  11, 20 E   | LIZATTHEW A WILL; ATTS LUYATT TARRANT & COTIBS (L. SOWEST STATESON STREET SITE!               |
|  | Espéditour:   |
| Etiquette entière à détacher et à coller par le guichetier au recto de l'envoi Recommandé Internation  | Spirke TRIBUD  1-10  SUSO CARCILLANGES  ME FRANCE   |
|  | ***   |
| Doestrataire de l'agrois (nom, adresse):    Doestrataire de l'agrois (nom, adresse):   TATIHEN A WILLIAMS     WAII TARRUT & COMBS LLP     SOO WEST TEFFELSON SPEET     SUITE L'800 CAUSVIIIE KY UPLA & A remoyer à l'appéditeur (  | AVIS DE PAIEMENT  AVIS DE PAIEMENT  Date de dépôt  nom, adresse): / To be returned to sender: |
| Remits / Dediversed Payle   Paid   Payle   Paid   Payle   Paid   Payle   Paid   Payle   Paid   Payle   Paid   Payle   Payle   Paid   Payle   P | 1) DIALO YASINN<br>2 SQUARE TRIBAD<br>080 CONRONRENNES  |
| 0011030001   | ակակկակակակարայիլուկական  |



### Case details for International Madrid(UK) Trade Mark M873089

Explanation of terms used on this page

Mark

HYPNOTIZER

Mark text:

HYPNOTIZER

Status

UK case status:

Opposition outstanding

Classes:

33, 32

Relevant dates

Date of international registration:

07 October 2005

Date of designation in UK:

07 October 2005

Next renewal date:

07 October 2015

Office of origin details

Office of origin:

France

Office of origin reference:

GM

Basic application or registration number Filing or registration date

053342166

07 October 2005

Publication in Trade Marks Journal

First advert:

Journal:

6628

http://www.ipo.gov.uk/madrid?madridnum=M873089

10/04/2010

Publication date:

07 April 2006

List of goods or services

Class 33:

Alcoholic beverages, wines, spirits.

Class 32:

Beers.

Names and addresses

Holder:

DIALLO YASSINN PATRICE 2, square Tribord, F-91080 COURCOURONNES, France

UK service:

M Diallo Yassinn Patrice C/o Willy Bozor 14 Abbey Court, 20 MacLeod Street, London, United Kingdom, SE17 3HA

#### Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

The "M" prefix is used purely within the UK and is not part of the Madrid(UK) registration number.

This enquiry shows information from the International Registration held by us. If you want to see details of the definitive International Registration, please visit the <u>World Intellectual Property Organization</u>.

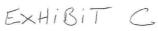


© Crown Copyright 2009

Intellectual Property Office is an operating name of the Patent Office

http://www.ipo.gov.uk/madrid?madridnum=M873089

10/04/2010





### Case details for Trade Mark 2462677

Explanation of terms used on this page

Case history including, where available, licensee details

| Mark                               |                                      |  |  |  |
|------------------------------------|--------------------------------------|--|--|--|
| Mark text:                         | HYPNOTIZER                           |  |  |  |
| Status                             |                                      |  |  |  |
| Status:                            | Refused                              |  |  |  |
| Class:                             | 33                                   |  |  |  |
| Status before death:               | Opposition outstanding               |  |  |  |
| Relevant dates                     |                                      |  |  |  |
| Filing date:                       | 30 July 2007                         |  |  |  |
| Progress stopped:                  | 16 April 2010                        |  |  |  |
| Publication in Trade Marks Journal |                                      |  |  |  |
| First advert:                      | Journal: 6711                        |  |  |  |
|                                    | Publication date: 23 November 2007   |  |  |  |
| List of goods or services          |                                      |  |  |  |
| Class 33:                          | Alcoholic beverages, wines, spirits. |  |  |  |

http://www.ipo.gov.uk/domestic?domesticnum=2462677

21/09/2010

Names and addresses

Proprietor:

Diallo Yassinn Patrice

2 Square Tribord Courcouronnes, 91080, France

Residence country:

France

Customer's ref:

TM "HYPNOTIZER"

ADP number:

0915387001

Agent:

Diallo Yassinn Patrice

c/o Bozor Willy, 69 Wyatt Park Road, London,

SW2 3TW

ADP number:

0946427001

Service:

Diallo Yassinn Patrice

c/o Bozor Willy, 69 Wyatt Park Road, London, SW2 3TW

ADP number:

0946427001

### Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

© Crown Copyright 2009

Intellectual Property Office is an operating name of the Patent Office

http://www.ipo.gov.uk/domestic?domesticnum=2462677

21/09/2010



INSTITUT

NATIONAL DE

LA PROPRIETE

INDUSTRIELLE

# DESSINS ET MODÈLES

Code de la propriété intellectuelle Livres IV : (Titre premier) V et VIII

EXHIBIT E

NOTIFICATION DE PUBLICATION ET CERTIFICAT D'IDENTITÉ

Le dépôt de dessin(s) ou modèle(s) dont les références et la(les) reproduction(s) figurent au verso a été publié au Bulletin officiel de la propriété industrielle n° 05/21 du 21 octobre 2005

La présente notification vaut certificat d'identité.

130504

Le Directeur général de l'Institut national de la propriété industrielle

Benoît BATTISTELLI

INSTITUT
TO NATIONAL DE Téléphone: 33 (0) 153 04 55 04
LA PROPRIETE
INDUSTRIELLE

ETABLISSEMENT PUBLIC MATIONAL

CREE PAR LA LO IN\* 51-444 DU 19 AVRIL 1951



DIALLO Yassinn 2 square Tribord 91080 COURCOURONNES

- (21) N°(s) d'enregistrement ou national : 05 0903
- 20 Dépôt du 18 février 2005, à PARIS Nombre total de dessins ou modèles : 2 Nombre total de reproductions : 2
- 71 Déposant(s): DIALLO Yassinn, Patrice, 2 square Tribord, 91080 COURCOURONNES
- Mandataire ou destinataire de la correspondance :
  DIALLO Yassinn, 2 square Tribord, 91080
  COURCOURONNES

Modèle(s) publié(s)

©1) Classement 09-03

1-1

- N°(s) de publication
   765 152 et 765 153
- (34) Nature du (des) objet(s): Emballage, Emballage et sa capsule

  D.M. nº 1 et 2: 1 repr.
- Date de publication : 21 octobre 2005
- ⑤ Description : Repr. 1-1 : Vue dépliée. ◆ Repr. 2-1 : Emballage et sa capsule



765 152



# EXHIBIT F



## EXHIBIT G





**United States Patent and Trademark Office** 

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

#### Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Sat Apr 17 04:02:18 EDT 2010



#### internet browser to return to 1233)

### **HYPNOTIZER**

Word Mark **HYPNOTIZER** IC 033. US 047 049. G & S: Alcoholic beverage produced from a brewed malt base with natural flavors, Alcoholic beverages of fruit, Alcoholic fruit extracts, Alcoholic malt coolers, Alcoholic punch, Cachaca, Cognac, Distilled Spirits, Fruit wine, Gin, Hard cider, Natural sparkling wines, Prepared alcoholic cocktail, Prepared wine cocktails, Rum, Sparkling fruit wine, Sparkling grape wine, Sparkling wines, Tequila, Vodka, Whiskey, Wine coolers, wines Goods and Standard Characters Claimed Mark Drawing (4) STANDARD CHARACTER MARK Serial Number 77266196 Filing Date August 28, 2007 Current Filing 1B Basis Original Filing 1B Basis Published for April 8, 2008 Opposition (APPLICANT) DIALLO YASSINN PATRICE INDIVIDUAL FRANCE 2 SQUARE TRIBORD Owner COURCOURÓNNES FRANCE 91080 Type of Mark TRADEMARK Register PRINCIPAL Live/Dead Indicator TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG TOP HELP http://tess2.uspto.gov/bin/showfield?f=doc&state=4005:svc73v.2.2 18/04/2010

## EXHIBIT I

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

United States Patent and Trademark Office

Reg. No. 2,642,855 Registered Oct. 29, 2002

**TRADEMARK** PRINCIPAL REGISTER

### **HPNOTIQ**

GLOBAL PERSPECTIVES, INC. (NEW YORK CORPORATION) 108-50 62ND DRIVE FOREST HILLS, QUEENS, NY 11375

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

SER. NO. 76-372,289, FILED 2-20-2002.

FOR: LIQUEUR, IN CLASS 33 (U.S. CLS. 47 AND 49).

YSA DEJESUS, EXAMINING ATTORNEY

de location d'enregistrements sonores, d'appareils audio, de bande vidéo, de caméras vidéo; montage de bandes vidéo; montage de programmes radiophoniques; montage de programmes de télévision; enrenistrement (Electrical de la companya de vidéo; publication d'informati bases de données; services d'e données, de sons et d'images pour l'enregistrement, la reprod'images.

EXHIBIT

Classes de produits ou services

Nº National: 05 3 342 166

Dépôt du : 18 FEVRIER 2005

à: I.N.P.I. PARIS

M DIALLO YASSINN PATRICE, 2 SQUARE TRIBORD, 91080 COURCOURONNES.

Mandataire ou destinataire de la correspondance : M DIALLO YASSINN, 2 SQUARE TRIBORD, 91080 COURCOURONNES.

#### HYPNOTIZER

Produits ou services désignés : Bières ; eaux minérales. Boissons alcooliques ; vins ; spiritueux.

Classes de produits ou services : 32, 33.

Nº National: 05 3 342 167

Dépôt du : 18 FEVRIER 2005

à: I.N.P.I. PARIS

CONFEDERATION NATIONALE DU CREDIT MUTUEL, association régie par la loi du 1er juillet 1901, 88-90, rue Cardinet, 75017 PARIS.

Mandataire ou destinataire de la correspondance : ERNEST GUTMANN, YVES PLASSERAUD, S.A., 3 rue Chauveau-Lagarde, 75008 PARIS.

### DOMI+

Produits ou services désignés : Matériels, équipements et dispositifs électroniques pour la télématique, l'informatique, la bureautique, la monétique ; appareils automatiques déclenchés par l'introduction d'une pièce de monnaie, d'un jeton ou d'une carte bancaire, distributeurs automatiques de billets; cartes bancaires; cartes à puce notamment cartes à mémoire, ou à micro-processeur ou magnétique ou à puce comportant un crédit d'unités, notamment d'unités téléphoniques; cartes téléphoniques; supports d'enregistrement magnétiques, numériques et optiques, cédérom, vidéodisques ; appareils pour l'enregistrement, la transmission, la reproduction du son ou des images; équipement pour le traitement de l'information et les ordinateurs; téléphones, téléphones boblies; assistant personnel (ordinateur), ordinateurs, ordinateurs portables, lecteur MP3; puces électroniques; cartes es IMI; logiciels, notamment logiciels pour le traitement de l'information, logiciels de jeux, appareils pour jeux conçus pour être utilisés seulement avec récepteur de télévision; jeux automatiques (machines) à prépaiement. Cartes en papier; cartes en carton; produits de l'imprimerie; b'ulletins et imprimés d'abonnements téléphoniques, d'abonnements à un service de radiotéléphonie, d'abonnements à un service de radiomessagrie, d'abonnement a un centre fournisseur d'accès à un réseau informatique ou de transmission de données, notamment de communication nondiale (de type Internet) ou à accès privé ou réservé (de type Intranet), d'abonnements à une base de données, d'abonnements à un service de communication; livres; revues; magazines; journaux; dépliants en papier, prospectus en papier, affiches, calendriers, autocollants, imprimés publicitaires,

formulaires ; papeterie ; matières plastiques pour l'amballage à savoir, sacs, sachets, films et feuilles. Publicité, services de location d'assavae me de l'étients. Services d'abonnements tiéphonie, rivier adiomessageire ; abonnements biéphonie, rivier adiomessageire ; abonnements à l'adonnées, abonnéens à l'adonnées, abonnements à l'adonnées, abonnées, abonnées services de télécomunication. Consultations professionnées services de télécomunication. Consultations professionnées de télécomunication. Consultations professionnées des les secteurs bancaire, financier, monétaire et boursier; consultations et informations dans le domaine de l'épargne ; analyses, estimations, informations dans le domaine de l'épargne ; analyses, estimations, informations dans le domaine de l'épargne ; analyses, estimations, informations dans le domaine de l'épargne ; analyses, estimations, informations et boursiers accessibles notamment par voles télématiques, par fesseux informatiques, sur les marchés financiers, monétaires et boursiers accessibles par otte de données informatiques, d'annuaires professionnels électroniques dans les secteurs bancaire, financier, optetique de données informatiques, d'annuaires professionnels électroniques dans les secteurs bancaires; affaires financières; effaires monétaires; affaires monétaires; affaires monétaires ; affaires buncaires; effaires monétaires; affaires buncaires; effaires monétaires; affaires buncaires; effaires monétaires; affaires buncaires; effaires monétaires; affaires immobilières; gestion de comptes. Assurances; affaires immobilières; pestion de comptes de tervices de lettres de crédit; services d'informations et expertises fiscales; recouverent de créances; effaires monétaires, affaires financières; effaires ducrés de lettres de crédit; services d'informations par voie téléma

(1-, 기계 1년

Alger

belgrade

fruzelles

bucarest

budapest

Cosentence

Hanoi

Istanbut

Landves



Mescou New York Paris Pékin Prague Rigas Shonghai Tunis Varsevie

EXHIBIT K

Grégoire Triet Associé Tél. +33 (0)1 40 75 61 51 Fax +33 (0)1 40 75 37 01

Monsieur M Diallo Yassinn Patrice 2, square Tribord 91 080 Courcouronnes

Paris, le 11 mai 2005

Lettre recommandée avec accusé de réception

Réf. : Dépôt de la marque verbale Hypnotizer n° 05 3 342 166

Monsieur,

triet@gide.com

Je suis le conseil de la société américaine Heaven Hill Distilleries, Inc., dont le siège social est situé 1064 Loretto Road – 40 004 Bardstown – Etats-Unis.

- 1. La société Heaven Hill Distilleries, Inc. est titulaire des marques suivantes :
  - marque française verbale "HPNOTIQ" enregistrée le 24 janvier 2002 sous le numéro 3 143 392 pour désigner les produits suivants en classe 33 : "liqueurs" ;
  - marque communautaire verbale "HPNOTIQ" déposée le 18 mars 2002 et enregistrée le 30 juin 2003 sous le numéro2 620 466 pour désigner les produits suivants en classe 33 : "liqueurs" ;
  - marque communautaire figurative déposée le 23 décembre 2002 et enregistrée le 8 mars 2004 sous le numéro 2 989 085 pour désigner les produits suivants en classe 33 : "liqueurs".

Les droits dont dispose la société Heaven Hill Distilleries, Inc. sur les signes précités lui confère un monopole absolu sur l'usage de ces signes et la faculté de s'opposer à tout dépôt et

ASSOCIATION D'AUGENTS À LA COUR DE PARIS

26, cours Albert 1er 75008 Paris Tél. +33 [0]1 40 75 60 00 Fax +33 [0]1 43 5

E-mail info@gide.com www.gide.com

usage de ceux-ci ou d'un signe similaire pour des produits ou services identiques ou similaires à ceux désignés par ces enregistrements.

- 2. Or, la société Heaven Hill Distilleries, Inc. a eu la surprise de constater que vous aviez procédé au dépôt, auprès de l'INPI, le 15 février 2005, de la demande d'enregistrement du signe "Hypnotizer" pour désigner les produits et services suivants des classes 32 et 33 : "Bières, eaux minérales, boissons alcooliques, vins, spiritueux".
- 3. Le signe que vous avez déposé est similaire à ceux qui ont été enregistrés par la société Heaven Hill Distilleries, Inc. et désigne des produits identiques ou à tout le moins similaires aux produits désignés par les marques de la société Heaven Hill Distilleries, Inc.

En conséquence, la société Heaven Hill Distilleries, Inc. considère que votre dépôt de marque porte atteinte à ses droits au sens de l'article L. 711-4 du Code de la propriété intellectuelle et est susceptible de constituer un acte de contrefaçon au sens de l'article L. 713-3 du même code.

4. C'est pourquoi, la société Heaven Hill Distilleries, Inc. vous demande de bien vouloir procéder au retrait total de votre demande de marque n° 05 3 342 166.

A défaut d'avoir reçu, au plus tard le 18 mai prochain, une réponse satisfaisante de votre part et la justification du retrait total de votre demande, la société Heaven Hill Distilleries, Inc. m'a d'ores et déjà chargé de former opposition à l'encontre de son enregistrement.

Je suis bien entendu à la disposition de celui de mes confrères auquel vous souhaiteriez confier la défense de vos intérêts pour m'entretenir de ce dossier avec lui.

Je vous prie de croire, Monsieur, à l'assurance de ma considération distinguée.

Grégoire Triet Avocat à la Cour



500 West Jefferson Street, Suite 2800 Louisville, Kentucky 40202-2898 502.589.5235 502.589.0309 Matthew A. Williams 502.562.7378 mwilliams@wyattfirm.com

EXHIBIT L

September 10, 2009

CONFIRMATION COPY

via EMAIL: <u>yassin.diallo@laposte.net</u> Confirmation via FedEx

Yassinn Patrice Diallo 2 Square Tribord COURCOURONNES 91080 FRANCE

> Re: US Opposition No. 91183753 UK Opposition No. 95763

Dear Mr. Diallo:

Enclosed with this letter is a copy of the decision the UK Trademark Registry recently issued in the favor of Heaven Hill Distilleries, Inc. ("Heaven Hill") that was forwarded to me by Heaven Hill's counsel in the UK, David Potter.

As I am sure you are aware from your own review of the decision, the Registry found in no uncertain terms that your proposed use of the HYPNOTIZER mark in connection with alcoholic beverages, spirits, and wines would create a likelihood of confusion in the marketplace. The Registry quite justifiably based this decision on the high degree of distinctiveness of Heaven Hill's HPNOTIQ mark when used with liqueurs, the high degree of similarity between the HPNOTIQ and HYPNOTIZER marks, and the identical or related nature of the parties' respective goods.

This now makes two countries that have properly concluded that your proposed use of the mark HYPNOTIZER in connection with alcoholic beverages would create a likelihood of confusion with Heaven Hill's use of its senior HPNOTIQ mark in connection with liqueur. Hopefully, you will now concede that Heaven Hill's rights in its HPNOTIQ mark simply preclude you from using or registering the HYPNOTIZER mark in connection with alcoholic beverages.

LOUISVILLE KY LEXINGTON KY BOWLING GREEN KY NEW ALBANY (N. NASHVILLE THE M.

WWW.WYATTFIRM.COM

1,000,000



Yassinn Patrice Diallo September 10, 2009 Page 2

We further note that the UK Registry's decision requires you to pay a contribution of £1,550 toward Heaven Hill's costs in prosecuting the opposition. Heaven Hill would, however, be willing to forego collection of these costs if you would agree to (1) not appeal the Registry's decision in the UK; (2) voluntarily abandon your U.S. application to register the HYPNOTIZER mark, Serial No. 77/266,196; and (3) undertake to not use the HYPNOTIZER mark in any country where Heaven Hill has registered its HPNOTIQ mark or where Heaven Hill sells its HPNOTIQ goods.

Should these terms be acceptable to you, please sign and return the enclosed copy of this letter acknowledging your acceptance of these terms along with documentation demonstrating that you have filed to voluntarily abandon U.S. Application Serial No. 77/266,196.

If, on the other hand, you proceed with appealing the UK decision, you should be aware that Heaven Hill will vigorously defend against such an appeal and seek a further award of costs to cover the costs it incurs in contesting the appeal of a well-reasoned decision by the Registry.

Please feel free to contact me if you would like to discuss any of these matters in further detail.

Very truly yours,

WYATT, TARRANT & COMBS, LLP

Multi-Villa-

Matthew A. Williams

MAW/dkl Enclosure

cc: David A. Calhoun, Esq. (via email)

David Potter, Esq. (via email)

20318862.2

AGREED TO, ACCEPTED, AND RECEIPT ACKNOWLEDGED BY:

Yassinn Patrice Diallo

Date



### **Trade Mark Enquiry**

New Search Amend Search
Search Results
Your search found 3 results. Page 1 of 1 is shown.

| Trade<br>Mark<br>No. | Mark Text  | File Date  | Status                 | Nice<br>Classes | Vienna<br>Classes                | Image      | Picking<br>List |
|----------------------|------------|------------|------------------------|-----------------|----------------------------------|------------|-----------------|
| M734514              | hypnotizer | 23/03/2000 | Expired                | 12              | 02.09.00<br>26.01.00<br>27.05.00 |            |                 |
| M873089              | HYPNOTIZER | 07/10/2005 | Opposition outstanding | 32 33           |                                  | HYPNOTIZER |                 |
| 2462677              | HYPNOTIZER | 30/07/2007 | Refused                | 33              |                                  |            |                 |

© Crown Copyright 2010

Intellectual Property Office is an operating name of the Patent Office

http://www.ipo.gov.uk/tm/t-find/t-find-text/tmtsearch-default.aspx

01/11/2010